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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,865	04/16/2004	Edgar Hommann	34206/US	8185
7590 David E. Bruhn, Esq. DORSEY & WHITNEY LLP Intellectual Property Department 50 South Sixth Street, Suite 1500 Minneapolis, MN 55402-1498			EXAMINER GILBERT, ANDREW M.	
			ART UNIT 3767	PAPER NUMBER
			MAIL DATE 08/21/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/825,865

**Applicant(s)**

HOMMANN ET AL.

**Examiner**

ANDREW M. GILBERT

**Art Unit**

3767

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/6/2008 has been entered.

### ***Acknowledgments***

2. This office action is in reply to the response filed on 8/6/2008.
3. In the reply, the Applicant amended claim 1 and 18.
4. Thus claims 1-16, 18 are pending for examination.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 4-7, 9-16, 18 are rejected under 35 U.S.C. 102(b) as being anticipated by D'Antonio et al (6056716). D'Antonio et al discloses an injection device (Fig 7E) for injecting a medicament into a body, the injection device comprising: a housing (707); a medicament reservoir housing the medicament (820); a drive system (703) for expelling

a dosage of the medicament from the reservoir; and at least one capacitor (348) for powering the drive system for performing at least one injection; wherein the medicament reservoir, the drive system, and the at least one capacitor are contained within the injection device housing (Fig 7E); wherein the at least one capacitor is the sole power source for injection device and receives its charge from a an external charging device external (950; Fig 7E; wherein the Examiner notes the power device 950 is external to – resides outside the housing - and removably coupled to the handle; the Examiner further suggests structurally defining the housing and/or the connection between the housing and the charge device – furthermore, the device is fully capable of having the power source 950 attached to the housing, used to charge the capacitor, and then decoupled from the housing, resulting the device being fully charged and functioning for injection) to and removably coupled to the injection device housing (col 25, Ins 14-16); and wherein the drive system remains operable for expelling a dosage after the charging device has been removed by discharging the charge from the external charging device (col 17, Ins 64-67). For claim 4-7, 9-16, see (col 16, Ins 10-col 18, ln 54).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over D'Antonio et al in. D'Antonio et al discloses the invention substantially as claimed except for expressly disclosing that the capacitor is made out of gold. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the capacitor as taught by D'Antonio et al with a gold capacitor since it was well known in the art that capacitors are made out of gold material.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over D'Antonio et al in view of Avarhami et al (6708060). D'Antonio et al discloses the invention substantially as claimed except for expressly disclosing the capacitor is a duplex capacitor. Avarhami et al teaches that it is known to have a duplex capacitor (col 18, lns 19-23, col 20, lns 45-55, col 21, lns 41-49) for the purpose of modulating charge delivery. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the capacitor as taught by D'Antonio et al with the duplex capacitor as taught by Avarhami et al for the purpose of modulating charge delivery.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over D'Antonio et al in view of Portner et al (4360019). D'Antonio et al discloses the invention substantially as claimed except for expressly disclosing a DC/DC converter operably coupled to the at least one capacitor. Portner et al teaches that it is known to have a DC/DC converter operable coupled to the at least one capacitor (col 9, lns 13-15) for the purpose of charging the capacitor to a voltage matching the required voltage from the motor. It would have been obvious to one having ordinary skill in the art at the time the

invention was made to modify the capacitor as taught by D'Antonion et al with the DC/DC converter as taught by Portner et al for the purpose of the purpose of charging the capacitor to a voltage matching the required voltage from the drive member.

***Response to Arguments***

11. Applicant's arguments with respect to claims 1-16, 18 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO 892 Form.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW M. GILBERT whose telephone number is (571)272-7216. The examiner can normally be reached on 8:30 am to 5:00 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Simons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew M Gilbert/

Examiner, Art Unit 3767

/Kevin C. Simmons/

Supervisory Patent Examiner, Art Unit 3767